

REMARKS

The Office action mailed on 21 April 2004 (Paper No. 3) has been carefully considered.

The specification and Abstract are being amended to correct minor errors and improve form, and a substitute specification is presented. Claims 2, 8 and 10 are being canceled without prejudice or disclaimer, and claims 1, 3, 5 thru 7, 9 and 11 thru 14 are being amended. Thus, claims 1, 3 thru 7, 9 and 11 thru 14 are pending in the application.

It is first noted that, on page 2 of the Office action, the Examiner acknowledged the filing and receipt of all of the priority documents under 35 U.S.C. §119. It is respectfully requested that that acknowledgment be indicated in the PTO form PTOL-326 in the next Office action.

In paragraph 3 of the Office action, the Examiner objected to the specification under 35 U.S.C. §112 (first paragraph) for informalities in the specification. As stated above, the specification is being amended to correct minor errors and improve form.

In particular, referring to paragraph 2 of the Office action, page 16, line 5 of the original specification (now appearing in paragraph [0036] of the substitute specification submitted herewith) is being amended to insert reference to block S404 of Figure 4 of the application. Therefore, the objection to the drawings set forth in paragraph 2 of the Office action no longer applies, and should be withdrawn.

With respect to the various informalities set forth in paragraph 3 of the Office action, the informalities set forth by the Examiner have been taken into account in amending the specification, and appropriate corrective action has been taken. Therefore, the rejection under 35 U.S.C. §112 (first paragraph) no longer applies, and should be

withdrawn.

In paragraph 5 of the Office action, the Examiner rejected claim 7 under 35 U.S.C. §102 for alleged anticipation by Heo *et al.*, U.S. Patent No. 5,825,990. In paragraph 7 of the Office action, the Examiner rejected claims 1 thru 6 and 8 thru 14 under 35 U.S.C. §103 for alleged unpatentability over Heo *et al.* '990 in view of Ishikawa *et al.*, U.S. Patent No. 5,289,532. For the reasons stated below, it is submitted that the invention recited in the claims, as now amended, is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §102 or §103.

Independent claims 1 and 7 are being amended to include the recitations from dependent claims 2 and 8, respectively. Accordingly, it is submitted that independent claims 1 and 7 recite the inventive process and apparatus, respectively, in a manner so as to distinguish the invention from the prior art cited by the Examiner.

Specifically, independent claim 1 now recites that the error information transmitted includes at least the telephone number of the second receiving facsimile machine (which is to receive facsimile messages in place of the first facsimile machine, at which the error occurred) and the error message. Similarly, independent claim 7 now recites that the informing means furnishes the transmitting facsimile apparatus with information concerning the nature of an error occurring at the first receiving facsimile machine, as well as a telephone number of a second receiving facsimile machine that is capable of receiving the facsimile message in the event of error occurring at the first receiving facsimile machine.

In rejecting claim 1 under 35 U.S.C. §103, the Examiner admitted (on page 5 of the Office action) that Heo *et al.* '990 "does not explicitly detail that a second phone number to a different fax machine is sent to the transmitting fax machine" (quoting from

page 5, lines 6-7 of the Office action). However, the Examiner cited Ishikawa *et al.* '532 as allegedly teaching a standard fax transmitting and receiving system, wherein "the system lets a transmitting fax machine know of a different phone number and a time data, when a voice request is made to the receiving fax machine" (quoting from page 5, lines 11-12 of the Office action). In that regard, the Examiner cited column 3, lines 19-65 of Ishikawa *et al.* '532.

However, a careful review of the cited passage of Ishikawa *et al.* '532 fails to reveal a disclosure of error information including a telephone number of a second receiving facsimile machine which is to receive a facsimile message in place of a first receiving facsimile machine at which error has occurred. Specifically, Figure 1 of Ishikawa *et al.* '532 is a block diagram showing functions of a facsimile terminal "serving as a remote station" (quoting from column 3, lines 23-24 of the patent), that is, a "first receiving facsimile machine" in the terminology of the claims. The patent then goes on to describe that telephone numbers are stored in a telephone number storing memory 8 of the receiving station, and that the telephone number is "an arbitrary telephone which seems to ensure a response to either the originating notice by telephone from the transmitting station or the telephone communication when no answering is made to the voice request" (quoting from column 3, lines 31-35 of Ishikawa *et al.* '532). The patent then further describes that the "transmitting station receives the receiving station information, that is, the telephone number and time data which are stored in the memories 8 and 9 in the remote station so that the transmitting station executes a predetermined processing for the originating notice on the basis of the above information" (quoting from column 3, lines 44-49 of Ishikawa *et al.* '532).

Thus, contrary to the assertion by the Examiner on page 5 of the Office action, Ishikawa *et al.* '532 does not disclose or suggest the transmission of "error information occurring at said receiving facsimile machine, wherein said error information includes at

least said telephone number of said second receiving facsimile machine and said error message" (quoting from the last paragraph of claim 1, as now amended). More specifically, Ishikawa *et al.* '532 does not disclose or suggest the transmission of error information which includes the telephone number of a second receiving facsimile station which is to receive facsimile messages in place of a first facsimile receiving station at which error has occurred. Rather, as indicated in column 3 of Ishikawa *et al.* '532, that patent teaches away from such a feature, in that it discloses provision of an "arbitrary telephone number" (quoting from column 3, lines 31-32 of the patent) by the receiving station to the transmitting station.

With respect to the rejection of claim 1 under 35 U.S.C. §103, it should also be noted that there is nothing within the "four corners" of Heo *et al.* '990, and the Examiner has not cited any portion thereof, which would motivate or instruct a person of ordinary skill in the art to seek and incorporate the disclosure of Ishikawa *et al.* '532 into a modification of the disclosure of Heo *et al.* '990. Moreover, as indicated above, even if the combination of references is a valid combination under 35 U.S.C. §103, the combination of those references does not produce the apparatus recited in claim 1, as amended.

With respect to the rejection of claim 7 under 35 U.S.C. §102, as well as the rejection of dependent claim 8 under 35 U.S.C. §103, as mentioned above, independent claim 7 and dependent claim 8 have been combined by amendment to form amended independent claim 7. However, the rejection under 35 U.S.C. §103 based on the combination of Heo *et al.* '990 with Ishikawa *et al.* '532 is not a valid rejection of independent claim 7, as now amended, for the same reasons set forth above relative to independent claim 1.

On page 8 of the Office action, with respect to the rejection of claim 8, the

Examiner states that Heo *et al.* '990 discloses "that the error message is sent back by way of a voice synthesizer to the transmitting fax machine and details what type of error message, and indirectly states that the user can send the message to another fax machine" (quoting from page 8, lines 13-15 of the Office action). It should be noted that, although there may be some suggestion in the primary reference that the user can send a message to another fax machine, the combination of the two references (and, in particular, the disclosure of Ishikawa *et al.* '532) teaches away from providing the user with a phone number for a second receiving facsimile machine since the telephone number stored in memory 8 of Ishikawa *et al.* '532, as discussed above, is an arbitrary telephone number, and is not the telephone number of a second receiving facsimile machine to which messages can be sent if an error has occurred at the first receiving facsimile machine.

On page 8 of the Office action, the Examiner goes on to state that it "would have been obvious to one of ordinary skill in the art at the time the invention was made that [sic] for a sender to know another fax number to transmit to the receiver when sending the error message would automatically have another fax number preprogrammed within its register to notify a transmitting machine in case of an error message" (quoting from page 8, lines 15-19 of the Office action). It is respectfully submitted that this is not the case since, as mentioned above, Ishikawa *et al.* '532 actually teaches away from the feature recited in the claims of the present application. Moreover, the Examiner cites no portion of the cited references in support of his assertion as to what would have been obvious to one of ordinary skill in the art.

For the reasons stated above, it is submitted that the invention, as recited in claims 1 and 7, as now amended, is distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §102 or §103.

Finally, corrected Figure 4 is being submitted herewith in order to correct a

spelling error in block S405. Entry of corrected formal Figure 4 and confirmation of the entry in writing in the next Office action are respectfully requested.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Amendment.

Respectfully submitted,



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